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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,364	06/02/2005	Congji Zha	304122001100	2661
25226 7590 03/13/2008 MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018				
EXAMINER				
MATOCHIK, THOMAS L.				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,364

**Applicant(s)**

ZHA ET AL.

**Examiner**

THOMAS MATOCHIK

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56, 58-85 and 87-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56, 58-85 and 87-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Comments***

Receipt of the amendments to claims 56, 87, 101 and 102 and cancellation of claims 57 and 86 received on 12/12/2007 is acknowledged. The claim objections relative to claims 101 and 102 are withdrawn.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56, 58-69, 72-75, 78, 87-88, 90, 94-97 and 103-107 are rejected under 35 U.S.C. (102b) as being anticipated by Rees et al (US 5,109,094).

**Regarding claim 56:** Rees teaches an organosilicon condensation product comprising a silicon compound having at least one silicon bonded hydroxyl group, and another silicon compound having at least one alkoxy group (-OR) bonded to silicon. The alkoxy R group contains 1 to 2 carbon atoms (col. 2, lines 56-65 and col. 4, lines 27-42). The molar ratio of silanol compound to alkoxy compound is 0.95 (col. 5, example 3). Further, any of calcium, magnesium, strontium, or barium hydroxides are used to catalyze the condensation reaction (col.3, lines 23 and 24). During the reaction, water is formed and is present in the reaction mixture (col. 3, lines 42 and 43).

**Regarding claim 58 and 59:** Rees teaches a polysiloxane condensate (col. 5, example 3).

**Regarding claims 60-65:** Rees teaches a silicon reactant having 2 or more silanols (col. 2, lines 46-51).

**Regarding claims 66-69:** Rees teaches a silanol containing phenyl and vinyl groups (col. 3, line 1-5).

**Regarding claims 72-75:** Rees teaches a silicon compound having an alkoxy silane containing two methoxy groups (col. 4, line 35).

**Regarding claim 78:** Rees teaches an alkoxy group (-OR) where R is methoxy (col. 4, line 35).

**Regarding claims 87, 88 and 90:** Rees teaches the use of both calcium and magnesium hydroxide catalysts (cols. 4&5, example 1).

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**Regarding claim 94:** Rees teaches the presence of water in the reaction mixture (col 3, lines 42 and 43).

**Regarding claim 95:** A filtration step was used to remove the catalyst (col 3, lines 65-67).

**Regarding claims 96 and 97:** Rees teaches the amount of catalyst used is between about 0.001% to about 5% by weight of the organosilicon compound (col. 3, lines 65-68).

**Regarding claims 103-105:** Rees teaches a reaction temperature range between about 30°C to about 200°C (col. 3, lines 36-38).

**Regarding claims 106-107:** The Office realizes that all of the claimed effects or physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients. Therefore, the claimed effects and physical properties, i.e. absorption values of 7 cm<sup>-1</sup> and 15 cm<sup>-1</sup> at about 2820 nm would inherently be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Claims 92, 93, 98-102 are rejected under 35 U.S.C. (102b) as being anticipated by Rees (US patent 5,109,094) when taken with The Encyclopedia of Polymer Science and Technology, Vol. 11, Silicones.

Rees teaches the claimed process as set forth above, regarding claim 56.

**Regarding claims 92, 93, 98-102:** The Encyclopedia of Polymer Science and Technology, Vol. 11, Silicones, provides evidence that during condensation reactions of organosilanol and alkoxy silanes, one mole of water and one mole of alcohol are generated per mole of silicon containing compounds (page 782, reaction sequence 23 and 24). In the broadest reasonable interpretation of the condensation reaction, the water content will pass through the concentration ranges stated in the claims during normal operation of the process from startup to steady-state.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 76, 77, 79-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rees (US 5,109,094) as applied to claims 56, 72 and 73 above, and further in view of Hayes (US 4,395,563). Rees teaches all the basic claims as above.

**Regarding claims 76 and 77:** Rees does not teach the use of 3 and 4 alkoxy groups on the silane molecule cited in the instant. However, Hayes teaches the use of tri and tetra alkoxy silanes leading to the formation of polysiloxane polymers. Rees and Hayes are analogous art since they both are from the same field of endeavor, namely silicon polymer condensation chemistry. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use tri and tetra alkoxy silanes to produce a wider range of branched and crosslinked polysiloxanes from Rees (Hayes, col. 5, lines 17-21).

Rees teaches all the basic claims as above.

**Regarding claim 79-82:** Rees does not teach the use of a crosslinkable group on the silane molecule cited in the instant. However, Hayes teaches the use of alkenyl substituted dialkoxy silanes leading to the formation of polysiloxane polymers. Rees and Hayes are analogous art since they both are from the same field of endeavor, namely silicon polymer condensation chemistry. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use crosslinkable alkoxy silanes to produce polymers which could be extended using hydrosilation chemistry (Hayes, col. 5, lines 53-68 and col. 6, lines 1-16).

Claims 89 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rees (US 5,109,094) as applied to claims 56 and 87 above, and further in view of Hayes (US 4,395,563). Rees teaches all the basic claims as above.

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**Regarding claims 89 and 91:** Rees does not teach the calcium and magnesium oxide catalysts cited in the instant. However, Hayes teaches the use of magnesium and calcium oxides as condensation catalysts leading to the formation of polysiloxane polymers. Rees and Hayes are analogous art since they both are from the same field of endeavor, namely silicon polymer condensation chemistry. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use calcium and magnesium oxide catalysts to better control the chain length of the polysiloxanes from Rees (Hayes, col. 3, lines 19-21 and 60-67).

Claims 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rees (US 5,109,094) as applied to claim 56, 60, 67, 68 and 69 above, and further in view of Friedrich et.al (US 2003/0216537). Rees teaches all the basic claims as above.

**Regarding claims 70 and 71:** Rees does not teach a crosslinkable group attached to the silanol compound as being an acrylate, styrene or epoxide. However, Friedrich teaches styrenic, acrylate and epoxy groups attached to silanol compounds used in the preparation of silicon polycondensates. Rees and Friedrich are analogous art since they both are from the same field of endeavor, namely silicon polymer condensation chemistry. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use specific crosslinking R groups on the alkoxy (-OR) monomer to provide greater chemical stability and to modify the physical properties, such as viscosity, of the condensed polymer (Friedrich, ¶ 0040 and 0041).

Claims 83 - 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rees (US 5,109,094) as applied to claim 56, 72, 73,79 and 81 above, and further in view of Roscher et.al (WO01/04186 ). US Patent 6,984,483 was used for the English translation of WO01/04186.

Rees teaches all the basic claims as above.

**Regarding claims 83-85:** Rees does not teach an alkoxy silane compound containing a 3-methacryloxypropyltrimethoxysilane or an epoxy group. However, Roscher et.al teaches 3-methacryloxypropyltrimethoxysilane and epoxy containing alkoxides in the preparation of silicon

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polycondensates. Rees and Roscher et al are analogous art since they both are from the same field of endeavor, namely silicon polymer condensation chemistry. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use 3-methacryloxypropyltrimethoxy and epoxy silanes in polycondensates as a means to create other polymers whereby polymerization of the double bonds results in lower shrinkage and less crack formation in the resulting polymer (Roscher, page 20, line 23, Example 1 and page 23, line 23 Example 8).

### ***Response to Arguments***

Applicant's arguments filed 12/12/2007 have been fully considered but they are not persuasive. With respect to the reference to an allowance of similar claims in application 10/308,562, now US patent 6,818,721, the Office examines each application on a case by case basis. The Office calls the applicant's attention to the following:

#### **Concerning 35 USC § 102(b) rejections of claims 56, 58-69, 72-75, 86-88, 90 and 92-107:**

The applicant's amendment to claims 56, 87, 101 and 102 do not change the previous rejections. US 5,109,094 to Rees specifically states "the catalyst (B) is any hydroxide of magnesium, calcium, barium or barium in their anhydrous or hydrated form" (col. 3, lines 23-24). Further, the process of Rees "is suitable for use in the preparation of a variety of organosilicon products by condensation. If desired there may be included with the silanol terminated polydiorganosiloxanes other organosilicon compounds such as alkoxysilanes which are reactive with the silanol containing reactant" (col. 4, lines 27-40). The examples of Rees (1-6) show that water of hydration is present in the group IIA metallic hydroxides which can be released upon heating the reaction mixture. Additionally, trace amounts of water are present in the calcium or magnesium hydroxide raw materials leading to hydrolysis of the alkoxysilane releasing methanol and promote further condensation of the silicon compounds. The applicant does not specify the amount of protic solvent needed to promote condensation.

Therefore, for the reasons stated above, the rejections of claims 56, 58-69, 87-88, 90 and 92-107 under 35 USC § 102(b) are maintained.

**Concerning 35 USC § 103(a) rejections of claims 56, 72-73:**

The applicant's argument concerning 35 USC § 103(a) rejections of claims 56, 72 and 73 is not clear. These rejections fall under 35 USC § 102(b) above and are maintained.

**Concerning 35 USC § 103(a) rejections of claims 76-77, 79-82, 89 and 91:**

Claim 56 stipulates using calcium or magnesium catalysts that are not phosphate or carbonate. Hayes (US 4,395,563) clearly shows using both magnesium and calcium oxides in the presence of water to condense alkoxysilanes into polysiloxanes (col. 3, lines 19-20 and col. 4, lines 30-40). The obviousness rejections are maintained.

**Concerning 35 USC § 103(a) rejections of claims 70 and 71:**

Friedrich (US 2003/0216537) suggests using alkaline earth hydroxides as condensation catalysts (§ 0088). Additionally, example 1 clearly shows that methanol is formed and then removed from the reaction mixture (§ 0113). Rees and Friedrich share the same technical challenges of producing novel polyorganosiloxanes. Therefore the 35 USC § 103(a) rejections are maintained.

**Concerning 35 USC § 103(a) rejections of claims 83-85:**

Roscher (WO01/04186) suggests using alkaline earth hydroxides as condensation catalysts (page 9, lines 19-20). The 35 USC § 103(a) rejections are maintained.



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### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MATOCHIK whose telephone number is (571)270-3291. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796  
February 28, 2008

TLM  
2/26/2008